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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,383	06/15/1999	BOMAN IRANI	5181-29600	4054

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EXAMINER

DINH, KHANH Q

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 04/24/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/333,383

Applicant(s)

IRANI, BOMAN

Examiner

Khanh Dinh

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on 2/7/2003, PROSECUTION IS HEREBY REOPENED. The Office Action sets forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 5-38 are presented for examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 5-18 and 21-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Rossmann US pat. No.5,809,415.

As to claim 5, Rossmann discloses a method for sending content to a small footprint device (portable device or PDA 101, 102 fig.1) comprising:

connecting the small footprint device (using 100 or 101 of fig. 1 to provide information to the computer network) to a first network (Cellular Telephone Network 110 fig. 1) communicating with a service accessible from the first network to send information to the service accessible from the first network storing the information (see figs. 1 and 2A, abstract, col.8 line 56 to col.8 line 60).

the small footprint device connecting to a second network (130 fig. 1), integrating a second service running on the small footprint device with a service accessible from the second network receiving the information, wherein the service accessible (using an application on the server computer on the computer network) from the second network receiving the information, wherein the second service running on the small footprint device for sending the content to the small foot print device (i.e., processing information received from the client device, see col.8 line 46 to col.9 line 54, col.10 line 14 to col.11 line 56 and col.15 line 36 to col.16 line 63).

As to claims 6, 26 and 33, Rossmann discloses displaying content (see col.13 lines 8-61).

As to claims 7, 27 and 34, Rossmann further discloses executing a service for displaying dynamically generated content and displaying dynamically displaying the content (see col.14 line 6 to col.15 line 34).

As to claims 8, 9, 28 and 35, Rossmann discloses rejecting and filtering the content (using the request fields including only information such as lists of the contents types acceptable to the clients, see figs. 8A and 8B, col.25 line 5 to col.26 line 59).

As to claims 10 and 11, Rossmann discloses the first network and second network are LAN and the service accessible from the first and second network executing on a computer system on the first and second network (LAN 130 fig.1, see fig.1 and col.10 line 14 to col.11 line 64 and col.14 lines 6-67).

As to claims 12 and 13, Rossmann discloses sending information regarding a user of the small footprint device to the service accessible from the first and second network and the service accessible from the first network, said service accessible from the first network generating content based on the information comprising the service accessible from the second network generating content based on the information regarding the user of the small footprint device including advertising content (see figs. 4's col.15 line 36 to col.16 line 63 and col.18 line 5 to col.19 line 41).

As to claim 14, Rossman discloses sending one or more of: demographic data of the user, buying habits of the user, web browsing of the users and geographic of the user (using the request fields including only information such as lists of the contents types acceptable to the clients, see figs. 8A and 8B, col.18 line 11 to col.19 line 41 and col.25 line 5 to col.26 line 59).

As to claims 15, 29 and 36, Rossmann discloses sending information specifying one or more items the user has purchased and generating the personal advertising content based on the user's store (see figs. 8A and 8B, col.18 line 11 to col.19 line 41 and col.25 line 5 to col.26 line 59).

As to claims 16, 17 and 32, Rossmann discloses specifying a store in which a user of the small footprint device is currently located and generating content based on the user's store (see col.17 lines 7-55 and col.18 line 11 to col.19 line 41).

As to claim 18, Rossmann discloses automatically connecting to the first network without a user requesting the small footprint device to connect to the first network (see col.23 line 3 to col.24 line 60 and col.25 line 53 to col.26 line 59).

As to claims 21 and 23, Rossmann discloses a first service executing on the small footing device communicating with the service accessible from the first and second network to send the information from the first and second network (see fig.1, col.10 line 14 to col.11 line 64 and col.14 lines 6-67).

Claim 22 is rejected for the same reasons set forth in claim 5. As to the added limitation, further Rossmann discloses the computer system connected though LAN (using LAN 130 fig.1, see fig.1 and col.10 line 14 to col.11 line 64 and col.14 lines 6-67).

As to claim 30, Rossman discloses a method for sending content to a small footprint device comprising:

connecting the small footprint device to a local area network LAN (using 100 or 101 of fig. 1 to provide information to the computer network LAN 130 fig.1) to a first network (Cellular Telephone Network 110 fig. 1) communicating with a first service executing on LAN to send to the first service (see figs. 1 and 2A, abstract, col.8 line 56 to col.8 line 60).

the first service executing on the LAN generating the content based on the information and communicate with the small footprint device to send the content to the small footprint device to send the information to the footprint device (i.e., processing information received from the client device, see col.8 line 46 to col.9 line 54, col.10 line 14 to col.11 line 56 and col.15 line 36 to col.16 line 63).

As to claims 24, 25 and 31, Rossman discloses storing information on a computer system and a file system is LAN (LAN 130 fig.1, see fig.1 and col.10 line 14 to col.11 line 64 and col.14 lines 6-67).

As to claims 37 and 38, Rossman discloses system comprising:

A small footprint device (100 or 101 fig.1) and a local area network (LAN 130 fig.1) including a first service operable connecting the small footprint device (using 100 or 101 of fig.1 to provide information to the computer network) and a second service operable to communicate with the small footprint device, wherein the small device is operable to connect to the LAN to send information to the first service (see figs. 1 and 2A, abstract, col.8 line 56 to col.8 line 60).

Wherein the first service operable on LAN, the second service operable to retrieve the stored information and generating content based on the information and send the content to the small footprint device (i.e., processing information received from the client device, see col.8 line 46 to col.9 line 54, col.10 line 14 to col.11 line 56 and col.15 line 36 to col.16 line 63) and the small footprint device is operable to display the content (see col.14 line 6 to col.15 line 34).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossman US pat. No.5,809,415 in view of Razavi et al, US pat. No.6,253,122.

Rossman's teachings still applied as in item 4 above. Rossman does not specifically disclose a Jini network. However, the Jini network is generally well known in the art as disclosed Razavi (see abstract, col.9 line 22 to col.10 line 31). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement a well-known network such as Jini network of Razavi into the computer system of Carnegie to process data information because it would have provided more utilizations of the computer system in the network environment.

Response to Arguments

7. Applicant's arguments with respect to claims 5-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Claims 5-38 are *rejected*.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 4:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh, can be reached on (703) 305-9648. The fax phone number for this group is (703) 746-7239.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.

Khanh Dinh
Patent Examiner
Art Unit 2155
4/17/2003



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